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Brief  
P. Walk  
9-9-03

PATENT  
Attorney Docket No.: 390780  
Express Mail Label No.: EV 210654201 US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellant: Wayne Edward Beimesch

Examiner: David A. Rogers

Serial No. 09/806,274

Group Art Unit: 2856

Filed: March 27, 2001

For: METHOD FOR MEASURING  
VOLATILE ORGANIC COMPOUNDS  
AND A KIT FOR SAME

Mail Stop: Appeal Brief-Patent  
Commissioner For Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Attention: Board of Patent Appeals and Interferences

**APPELLANT'S BRIEF IN REPLY TO EXAMINER'S ANSWER (37 CFR §1.192)**

This Brief in Reply to Examiner's Answer is in furtherance of the Notice of Appeal filed on December 24, 2002, in the above-identified patent application.

This brief provides further arguments in support of the appeal of the final rejection of Claims 1-10 in the Advisory Action mailed on October 24, 2002.

**I. REAL PARTY IN INTEREST**

Midwest Research Institute is the real party in interest of the instant appeal.

**II. RELATED APPEALS AND INTERFERENCES**

As provided previously.

**III. STATUS OF CLAIMS**

As provided previously.

**IV. STATUS OF AMENDMENTS**

As provided previously.

**V. SUMMARY OF THE INVENTION**

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All references to page numbers refer to the Appellant's specification. Appellant's invention relates to the discovery of methods for measuring volatile organic compounds of a material produced in a process system having emissions, as further defined by the specification and Claims. Appellant's specification specifically further defines the invention at least on pages 1-2.

## VI. ISSUES

The Examiner has rejected Claims 1-7 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 5,140,845 to Robbins. In addition, Claims 8-10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 4,930,906 to Hemphill. Appellant maintains the Examiner has erred in rejecting Claims 1-7 and Claims 8-10 under 35 U.S.C. § 103(a).

## VII. GROUPING OF CLAIMS

As provided previously.

## VIII. ADDITIONAL ARGUMENTS - REJECTIONS UNDER 35 U.S.C. § 103(a)

The Examiner erred in contending that Claims 1-7 and Claims 8-10 are unpatentable under 35 U.S.C. § 103(a) over Robbins and Hemphill, respectively.

Claims 1-7 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Robbins. Appellant's invention teaches a method for measuring volatile organic compounds (VOCs) of material produced in a process system having emissions. Examples of process systems in which this method may be utilized are provided in Appellant's specification at least on page 4, and include spray dryers, mixers, fluid bed dryers and coolers, and storage tanks. All of these systems are closed systems, and as such have dynamic air flow properties. Appellant maintains that Appellant's claims must be read in light of the specification.

Further, the Examiner admits that Robbins does not teach the measurement of VOCs in a process system, but attempts to persuade the panel that "it is well known in the art that temperature affects the mass transfer coefficient, and, therefore, the time needed to obtain equilibrium of the headspace." The Examiner goes on to state that "one of ordinary skill in the art would be highly motivated to ensure that the material is subjected to its expected operating conditions in order to accurately determine if VOCs are being released." As support for this

argument, the Examiner argues that where the conditions of a claim are disclosed in the prior art, discovering the optimum or workable range involves only routine skill in the art, citing *In re Aller*.

Appellant maintains that the Examiner has applied the wrong analysis for determining obviousness under 35 U.S.C. § 103(a). Specifically, Appellants maintain that the invention as claimed and on appeal relates to the measurement of VOCs in a system having emissions, where said systems are taught in the specification include spray dryers, mixers, fluid bed dryers and coolers, and storage tanks. The Robbins reference teaches the measurement of VOCs in a sample of ground water or soil mixed with water. Appellant fails to find the nexus between systems having emissions as disclosed in Appellant's application and claims and the teachings of Robbins, where the sample to be measured is a sample of ground water or soil mixed with ground water. As discussed previously, the Robbins' system is a closed system by virtue of measuring the contents of the sample of ground water or soil so collected in a bag, and as such, Robbins does not teach or suggest the generation or measurement of volatile constituents produced in a **process system having emissions** as described in Appellant's invention. Specifically, the leakage of underground storage tanks and the testing of the contaminated soil resulting therefrom as described in Robbins is an **open system**, and does not teach or suggest the measurement of VOCs generated in the **closed systems of Appellant's invention**. The Examiner's logic in this regard would render obvious any and all measurements of volatile constituents generated in any system. Robbins therefore does not support the obviousness rejection of Appellant's invention. There is no teaching or suggestion of a method for measuring volatile organic compounds (VOCs) of material produced in a **process system having emissions** as claimed and provided by way of Appellant's invention. A *prima facie* case of obviousness has not been established.

Claims 8-10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 4,930,906 to Hemphill. Appellant notes that the Examiner's statement in Examiner's Answer dated June 26, 2003, once again states that the Hemphill reference "anticipates" Appellant's invention. Appellant maintains this statement is in error. The rejection of record at

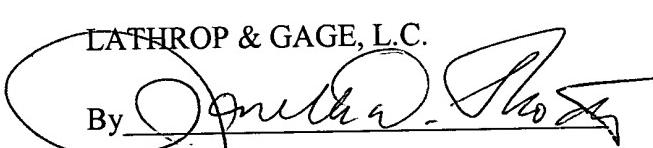
this time of Claims 8-10 over Hemphill is an obviousness rejection. As so stated, the Examiner refers to an "anticipation" rejection. This is clearly in error.

Hemphill teaches a cooking grease disposal bag. Hemphill does not teach or suggest a kit for measuring volatile organic compounds produced in a **process system having emissions** as provided by way of Appellant's invention. The Examiner states that "if the prior art structure is capable of performing its intended use, then it meets the claim" as support for the rejection of Claims 8-10 over the Hemphill reference. Appellant maintains that Hemphill does not teach or suggest a process system having emissions, nor does Hemphill teach or suggest a kit for measuring VOCs produced in same, nor does Hemphill teach or suggest volatile organic compounds being emitted **in any system**. Appellant maintains the current rejection of Claims 8-10 over Hemphill is analogous to making an obviousness rejection of Claims 8-10 over any resealable bag. The logic of the Examiner's argument is not supported. There simply is no teaching or suggestion in Hemphill of Appellant's kit for measuring VOCs in a **process system having emissions** as claimed. A *prima facie* case of obviousness has not been established.

Appellant respectfully requests the Honorable Board of Appeals reverse the Examiner in the rejections of Claims 1-7 and Claims 8-10 under 35 U.S.C. § 103(a). Appellant respectfully solicits allowance of Claims 1-10, all of the Claims appealed and pending in the instant application.

Respectfully submitted,

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## APPENDIX OF THE CLAIMS ON APPEAL

1. A method for measuring volatile organic compounds of a material produced in a process system having emissions, said method comprising:
  - (a) disposing an amount of said material in an enclosed bag having a sealable opening such that there is headspace above said material in said enclosed bag;
  - (b) storing said enclosed bag containing said solid material at the mean exit temperature of said emissions of said system such that equilibrium between said material and said headspace is reached; and
  - (c) introducing samples from said headspace into a flame ionization detector which thereby measures said volatile organic compounds of said material.
2. The method of claim 1 wherein said system is a fluid bed dryer.
3. The method of claim 1 wherein said system is a spray dryer.
4. The method of claim 1 wherein said storing step is for from about 5 hours to about 24 hours.
5. The method of claim 1 wherein said amount of said material is from about 1 gram to about 100 grams.
6. The method of claim 1 wherein said system is a storage tank.
7. The method of claim 1 wherein said mean exit temperature is from about 5 °C to about 100 °C.
8. A kit for measuring the volatile organic compounds of a material produced in a process system having emissions, said kit comprising:
  - (a) an enclosed bag having a sealable opening to allow an amount of said material to be placed in said enclosed bag such that there is headspace above said material; and
  - (b) instructions for analyzing samples from said headspace in said enclosed bag, thereby providing said volatile organic compounds of said material.

9. The kit of claim 8 wherein said instructions for analyzing said samples include withdrawing said samples from said headspace using a flame ionization detector.

10. The kit of claim 8 wherein said instructions for analyzing samples include storing said enclosed bag in a temperature adjustable apparatus.



08-28-03

AF/2856

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Applicant(s): Wayne Edward Beimesch

Matter No.

390780

Serial No.	Filing Date	Examiner	Group Art Unit
09/806,274	March 27, 2001	David A. Rogers	2856

Invention      Method For Measuring Volatile Organic Compounds And A Kit For Same

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		Application Number	09/806,274
		Filing Date	March 27, 2001
		First Named Inventor	Wayne Edward Beimesch
		Art Unit	2856
		Examiner Name	David A. Rogers
Total Number of Pages in This Submission		Attorney Docket Number	390780

## ENCLOSURES (check all that apply)

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<input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53		

## SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	Janelle D. Strode LATHROP & GAGE LC
Signature	
Date	August 27, 2003

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